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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/608,290  | 06/27/2003  | Jerry E. Elliott     | CASC 10-CIP         | 8523             |
| 43031   | 7590        | 09/08/2005           | EXAMINER            |                  |
| THOMAS E. HILL<br>EMRICH & DITHMAR, LLC<br>125 SOUTH WACKER DRIVE, SUITE 2080<br>CHICAGO, IL 60606-4401 |             |                      | DUNWOODY, AARON M   |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 3679                |                  |

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/608,290

Applicant(s)

ELLIOTT, JERRY E.

Examiner

Aaron M. Dunwoody

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9/29/2003</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Election/Restrictions***

None of the claims are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 7/8/2005.

### ***Priority***

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. However, the Applicant should update the status of Application Number 10/393,820 in the first paragraph of the disclosure.

### ***Information Disclosure Statement***

The information disclosure statement (IDS) filed 9/29/2003 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the handle comprised of rubber or an elastic material must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended

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replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

The disclosure is objected to because of the following informalities:

A brief description of Figures 11A and 11 B is missing.

Appropriate correction is required.

### ***Double Patenting***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in

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scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-40 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-26 of copending Application No. 10/701,219. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-40 are rejected under 35 U.S.C. 102(b) as being anticipated by US patent 1885128, Montgomery.

In regards to claim 1, in Figures 3-6, Montgomery discloses an apparatus comprising: a body portion having first and second opposed ends; an arm having a first end pivotally coupled to the body portion adjacent the first end thereof, the arm further including a second opposed end adapted for insertion in an aperture in the first edge flange of the repair clamp; a clasp pivotally coupled to the body portion intermediate the first and second opposed ends thereof and adapted to engage an outer edge of the repair clamp's second edge flange when the body portion is in a first position relative to the arm and clasp and the repair clamp is loosely disposed about the pipe, wherein pivoting displacement of the body portion about the arm and clasp to a second position draws the repair clamp's edge flanges together for securely maintaining the repair

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clamp on and in engagement with the pipe and allowing the nut and bolt combinations to be tightened for securing the repair clamp to the pipe in a sealed manner; and adjustable means coupling the clasp to the body portion for adjusting spacing between the arm and the clasp to accommodate a range of sizes of the repair clamp and diameters of the pipe.

Note, **the repair clamp is not part of the claimed invention.**

In regards to claim 2, in Figures 3-6, Montgomery discloses the clasp includes a first end engaging the outer edge of the repair clamp's second edge flange and a second opposed end pivotally coupled to the adjustable means on the body portion.

In regards to claim 3, in Figures 3-6, Montgomery discloses a first pivot pin coupling the second end of the clasp to the adjustable means, wherein the adjustable means includes an elongated slot disposed in the body portion and having plural engaging members disposed in a spaced manner along the length of the slot for engaging the first pivot pin and establishing spacing between the arm and the clasp.

In regards to claim 4, in Figures 3-6, Montgomery discloses each of the engaging members includes a pair of concave recesses in facing relation within the elongated slot, with plural pairs of facing concave recesses disposed in a spaced manner along the length of the elongated slot, and wherein each pair of facing concave recesses securely engages the first pivot pin in a releasable manner.

In regards to claim 5, in Figures 3-6, Montgomery discloses the clasp includes a first hook disposed on its first end for engaging the outer edge of the repair clamp's

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second edge flange and a second hook disposed on its second opposed end and positioned about the first pivot pin.

In regards to claim 6, in Figures 3-6, Montgomery discloses the first pivot pin includes a first pair of opposed convex portions and a second pair of opposed flat portions disposed in an alternating manner about its circumference, and wherein the convex portions are adapted for secure engagement with opposed facing pairs of concave recesses in the elongated slot for fixedly coupling the clap to the body portion, and wherein the first pivot pin is movable along the length of the slot for repositioning the first pivot pin within the slot when the opposed the portions of the first pivot pin are in facing relation to the opposed convex portions of the slot.

In regards to claim 7, in Figures 3-6, Montgomery discloses the body portion includes first and second connected members forming a handle at respective first connected ends thereof.

In regards to claim 8, in Figures 3-6, Montgomery discloses second opposed ends of the first and second members arranged in a spaced manner from each other and wherein the arm and the clasp are disposed between the first and second members adjacent the second ends thereof

In regards to claim 9, in Figures 3-6, Montgomery discloses a second pin pivotally coupling the arm to the body portion, wherein the first and second pins are disposed between and coupled to the first and second members.

In regards to claim 10, in Figures 3-6, Montgomery discloses the adjustable means further includes first and second elongated linear slots respectively disposed in

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the first and second members with each of the slots having plural engaging members disposed in a spaced manner along the respective lengths thereof, and wherein the engaging members in the first slot engage a first end of the second pivot pin and the engaging members in the second slot engage a second opposed end of the second pivot pin.

In regards to claim 11, in Figures 3-6, Montgomery discloses the arm and the clasp are disposed in closely spaced, aligned relation when the body portion is pivotally displaced to the second position.

In regards to claim 12, in Figures 3-6, Montgomery discloses a handle disposed on the second end of the body portion.

In regards to claim 13, in Figures 3-6, Montgomery discloses the handle is comprised of rubber or an elastomeric material.

In regards to claim 14, in Figures 3-6, Montgomery discloses the second end of the arm includes a hook structure for insertion into the aperture when the body portion is in the first position, and wherein the hook structure cannot be removed from the aperture when the body portion is in the second position for locking the repair clamp in position on the pipe.

In regards to claim 15, in Figures 3-6, Montgomery discloses the aperture is in the form of a slot and the hook structure includes first and second coupled flat portions having approximately 90 degrees relative orientation.



In regards to claim 16, in Figures 3-6, Montgomery discloses the clasp is generally C-shaped and includes an elongated slot for engaging an outer edge of the repair clamp's second edge flange.

In regards to claim 17, in Figures 3-6, Montgomery discloses the apparatus is comprised of high strength steel.

In regards to claim 18, in Figures 3-6, Montgomery discloses first and second pins attached to the body portion for pivotally coupling the clasp and arm, respectively, to the body portion, and wherein the second pin forms an axis of rotation about which the body portion rotates when moved between the first and second positions.

In regards to claim 19, in Figures 3-6, Montgomery discloses the first and second pins and an end portion of the clasp engaging an outer edge of the repair clamp's second edge flange are in general linear alignment when the body portion is in the second position.

In regards to claim 20, in Figures 3-6, Montgomery discloses the body portion is pivotally displaced about the second pin in moving the body portion from the first to the second position in removing the apparatus from the repair clamp.

In regards to claim 21, in Figures 3-6, Montgomery discloses an apparatus comprising: an elongated body having first and second opposed ends and an intermediate portion disposed therebetween; an arm having a first end pivotally coupled to the body adjacent the first end thereof by means of a first pivot pin and a second opposed end adapted for insertion in an aperture in the first edge flange of the repair clamp; a clasp pivotally coupled by means of a second pivot pin to the body

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intermediate the first and second opposed ends thereof and adapted to engage an outer edge of the repair clamp's second edge flange when the body is in a first position relative to the repair clamp and the repair clamp is loosely disposed about the pipe, wherein pivoting displacement of the body about the first pivot pin in a direction away from the repair clamp's second edge flange to a second position relative to the repair clamp draws the second end of the arm and the clasp as well as the repair clamp's first and second edge flanges together, and wherein the inner liner and cylindrical body of the repair clamp are securely maintained in engagement with the pipe about its outer periphery allowing the nut and bolt combinations to be tightened for securing the pipe clamp to the pipe in a sealed manner; and adjustable means coupling for changing spacing between the arm and the clasp to accommodate a range of sizes of the repair clamp and diameters of the pipe.

Note, **the repair clamp is not part of the claimed invention.**

In regards to claim 22, in Figures 3-6, Montgomery discloses the body includes first and second spaced, generally parallel members, with the first and second pins disposed between and coupled to the first and second members.

In regards to claim 23, in Figures 3-6, Montgomery discloses a handle disposed on the second end of the body.

In regards to claim 24, in Figures 3-6, Montgomery discloses the handle is comprised of rubber or an elastomeric material.

In regards to claim 25, in Figures 3-6, Montgomery discloses the second end of the arm includes a hook structure for insertion into the aperture when the body is in the

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first position, and wherein the hook structure cannot be removed from the aperture when the body is in the second position for locking the repair clamp in position on the pipe.

In regards to claim 26, in Figures 3-6, Montgomery discloses the aperture is in the form of a slot and the hook structure includes first and second coupled flat portions having generally 90 degrees relative orientation.

In regards to claim 27, in Figures 3-6, Montgomery discloses the clasp is curvilinear in shape having a first end coupled to the second pivot pin and a second opposed end engaging the outer edge of the repair clamp's second edge flange.

In regards to claim 28, in Figures 3-6, Montgomery discloses the second end of the clasp is generally in the form of a hook.

In regards to claim 29, in Figures 3-6, Montgomery discloses the apparatus is comprised of high strength steel.

In regards to claim 30, in Figures 3-6, Montgomery discloses the first pin forms an axis of rotation about which the body rotates when moved between the first and second positions.

In regards to claim 31, in Figures 3-6, Montgomery discloses the first and second pins and the second end of the clasp are in general linear alignment when the body is in the second position.

In regards to claim 32, in Figures 3-6, Montgomery discloses the adjustable means changes spacing between the arm and the clasp, bringing the arm and clasp

closer together for smaller pipe clamps and pipe diameters and moving the arm and clasp apart for larger pipe clamps and pipe diameters.

In regards to claim 33, in Figures 3-6, Montgomery discloses the clasp includes a first end engaging the outer edge of the repair clamp's second edge flange and a second opposed end pivotally coupled to the second pivot pin.

In regards to claim 34, in Figures 3-6, Montgomery discloses the adjustable means includes an elongated slot disposed in the body portion and having plural engaging members disposed in a spaced manner along the length of the slot for engaging the first pivot pin and establishing spacing between the arm and the clasp.

In regards to claim 35, in Figures 3-6, Montgomery discloses each of the engaging members includes a pair of concave recesses in facing relation within the elongated slot, with plural pairs of facing concave recesses disposed in a spaced manner along the length of the elongated slot, and wherein each pair of facing concave recesses securely engages the first pivot pin in a releasable manner.

In regards to claim 36, in Figures 3-6, Montgomery discloses the clasp includes a first hook disposed on its first end for engaging the outer edge of the repair clamp's second edge flange and a second hook disposed on its second opposed end and positioned about the second pivot pin.

In regards to claim 37, in Figures 3-6, Montgomery discloses the second pivot pin includes a first pair of opposed convex portions and a second pair of opposed flat portions disposed in an alternating manner about its circumference, and wherein the convex portions are adapted for secure engagement with opposed facing pairs of

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concave recesses in the elongated slot for fixedly coupling the clasp to the body portion, and wherein the second pivot pin is movable along the length of the slot for repositioning the first pivot pin within the slot when the opposed flat portions of the first pivot pin are in facing relation to the opposed convex portions of the slot.

In regards to claim 38, in Figures 3-6, Montgomery discloses the body portion includes first and second connected members forming a handle at respective first connected ends thereof.

In regards to claim 39, in Figures 3-6, Montgomery discloses second opposed ends of the first and second members are arranged in a spaced manner from each other and wherein the arm and the clasp are disposed between the first and second members adjacent the second ends thereof.

In regards to claim 40, in Figures 3-6, Montgomery discloses the arm and the clasp are disposed in closely spaced, aligned relation when the body portion is pivotally displaced to the second position.

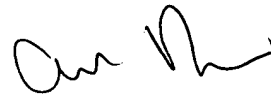
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron M. Dunwoody whose telephone number is 571-272-7080. The examiner can normally be reached on 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 571-272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Aaron M Dunwoody  
Primary Examiner  
Art Unit 3679

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